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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91222999
Party	Plaintiff Urgent Care MSO, LLC
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Signature	/Lauren M. Gregory/
Date	06/03/2016
Attachments	Response to Videokall Submission.pdf(34464 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/414,664
Published in the Official Gazette of March 31, 2015

URGENT CARE MSO, LLC,

Opposer,

v.

VIDEOKALL, INC.,

Applicant.

Opposition No. 91222999

RESPONSE IN OPPOSITION TO APPLICANT’S “NOTICE TO DISMISS”

Opposer Urgent Care MSO, LLC (“Opposer”) hereby responds and opposes the April 22, 2016 submission by Applicant VideoKall, Inc. (“Applicant”) styled “Notice to Dismiss by Applicant” as follows:

INTRODUCTION

On April 22, 2016, Applicant filed a “Notice to Dismiss by Applicant” (“Applicant’s Submission” or “Submission”), which was apparently intended to function as a motion to dismiss for lack of prosecution. [9 TTABVUE.] Applicant failed to serve Opposer with a copy of the Submission. Therefore, Opposer was unaware of the Submission until after the fifteen-day response period had expired. Opposer, having happened upon the Submission while viewing the TTABVUE page for this proceeding, now seeks leave to file this response outside the standard fifteen-day period for good and sufficient cause.

A response is required in order to demonstrate to the Board that the Submission is both untimely and improper. In essence, Applicant is seeking dismissal of this proceeding because it

is dissatisfied with Opposer's settlement proposals and feels that Opposer has failed "to produce any credible arguments." [Submission, p. 1.] Applicant also alludes to an alleged failure to produce evidence, despite the fact that Opposer's pretrial disclosures are not due until July 14, 2016, and Opposer's opening trial testimony period does not close until August 28, 2016. These are not proper grounds for a motion to dismiss for lack of prosecution pursuant to 37 CFR § 2.132, which will not ripen until *after* the close of Opposer's opening trial period. Therefore, the Board must deny the relief Applicant is seeking.

BACKGROUND

Opposer initiated this proceeding on July 28, 2015. [1 TTABVUE.] Applicant was originally subject to an answer deadline of September 6, 2015, [2 TTABVUE 3], but sought an extension. [4 TTABVUE.] Applicant did not include a certificate of service with the Motion for Extension, and did not serve Opposer with a copy of that pleading. [See *id.*] In fact, Applicant stated affirmatively that it had "NOT notified the Opposer of this motion for extension." [*Id.*] (emphasis in original).

Nonetheless, the Board issued an Order granting Applicant's Motion for Extension "as conceded" and set forth discovery and trial dates for this proceeding. [5 TTABVUE 1.] Pursuant to this Order, discovery opened on December 2, 2015 and closed on May 30, 2016.¹ [*Id.*] Opposer has until July 14, 2016 to serve its pretrial disclosures, and its 30-Day Trial Period ends on August 28, 2016. [*Id.*]

Applicant filed a response to Opposer's Notice of Opposition entitled "Notice of Opposition by Applicant" on October 27, 2015, again failing to serve Opposer and affirmatively

¹ Monday, May 30, 2016 fell on Memorial Day. "If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or federal holiday within the District of Columbia, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) may be served, and discovery depositions may be taken, on the next business day." TBMP § 112. Therefore, the last day to serve discovery in this proceeding was on Tuesday, May 31, 2016.

stating that it had “not provided a copy of this submittal to the Opposer.” [6 TTABVUE 6.] Shortly thereafter, Opposer retained its current counsel, which entered an appearance on December 9, 2015. [7 TTABVUE.] The parties have conducted a discovery conference, and Opposer has served Applicant with its Initial Disclosures and with its First Requests for Production of Documents, First Interrogatories, and First Requests for Admission. [Declaration of Lauren M. Gregory, attached as Exhibit A hereto, at ¶¶ 2, 6.] Opposer did not receive any Initial Disclosures or any requests for discovery from Applicant during the discovery period. [Id. at ¶ 7.]

During the discovery conference, the parties discussed the possibility of settlement, but did not reach consensus on specific settlement terms. [Id. at ¶ 2.] The parties discussed settlement again during a teleconference held on March 3, 2016. [Id. at ¶ 3.] After that teleconference, Opposer was left with the impression that settlement talks would continue. [Id.]

Instead, Applicant sent the Submission to the Board, which was received and docketed on April 22, 2016. [9 TTABVUE.] Applicant did not include a certificate of service with the Submission, [see id.], and Opposer never received a copy of it. [Ex. A at ¶ 4.] Opposer would not have known of the existence of the Submission had its counsel not happened to check the docket on the Board’s website. [Id. at ¶ 5.]

ARGUMENT

A. The Board Should Not Grant Applicant’s Submission as Conceded.

Normally, the party required to respond to a motion to dismiss is served with a copy of the filing, and has fifteen days from the date of service “to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, judgment may be rendered against the party in the position of plaintiff.” 37 CFR § 2.132(a). In this case,

Opposer was never served, and thus the timeline for response should not have started. However, out of an abundance of caution, knowing that “[w]hen a party fails to file a brief in response to a motion, the Board may treat the motion as conceded,” 37 CFR §§ 2.127(a), Opposer seeks the Board’s permission to file this Response more than fifteen days after the Submission was originally filed with the Board.

The Board may enlarge a scheduled period of time for a party to act “where the failure to act was the result of excusable neglect.” Fed. R. Civ. P. 6(b); *see also* 37 CFR § 2.116(a) (incorporating the Federal Rules of Civil Procedure for inter partes trademark proceedings).

[T]he determination as to whether a party’s neglect is excusable is “at bottom an equitable one, taking account of all relevant circumstances surrounding the party’s omission. These include...[1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.”

HKG Indus. Inc. v. Perma-Pipe Inc., 49 USPQ2d 1156, 1157 (TTAB 1998) (quoting *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P’ship*, 507 U.S. 380, 395 (1993)).

The factors in this case all weigh toward reopening Opposer’s response period. Without an opportunity to respond to the Submission, Opposer would suffer severe prejudice because it would face potential dismissal of this proceeding, which it has lodged to protect its rights in its valuable MEDEXPRESS trademarks. The brief delay of a few weeks should not impact this proceeding. *Cf. Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701, 1704 (TTAB 2002) (finding delay improper where party waited eleven months to determine the status of a proceeding, failing to access filings online during that period). This delay was not caused by Opposer, who was unaware of the filing and is now attempting to respond promptly and in good faith. Moreover, given Applicant’s past practice of defying the Board’s rules by

intentionally failing to serve documents, it is reasonable to conclude that Applicant took the same tack here.

In any event, the Board may exercise discretion to consider Opposer's Response and incorporated brief even if it was not filed on a timely basis. *See, e.g., W. Worldwide Enters. Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (evaluating motion on the merits despite untimely responsive filing); *Consolidated Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619, 620 (TTAB 1986) ("[W]e do not treat Consolidated's motion as having been conceded due to Berkshire's default in not responding."); *see also* TBMP § 502.04 (explaining that the Board, "in its discretion, may also decline to treat an uncontested motion as conceded, and may grant or deny the motion on its merits"). In light of the fact that Applicant's Submission is meritless, Opposer respectfully requests that the Board consider its Response.

B. The Board Should Deny Applicant's Submission as Untimely.

Construing Applicant's Submission, inexplicably labeled a "Notice to Dismiss," as a motion for dismissal for failure to prosecute pursuant to 37 CFR § 2.132, it is premature and should be denied on that basis.

A party may move for dismissal on the ground of the failure of the plaintiff to prosecute, but not until *after* "the time for taking testimony by any party in the position of plaintiff [*i.e.*, Opposer] has expired." 37 CFR § 2.132; *see also Old Nutfield Brewing*, 65 USPQ2d at 1702 (TTAB 2002) ("[W]hen a plaintiff fails to offer testimony or other evidence during its testimony period, the defendant may move for dismissal for failure to prosecute."). In this case, Opposer's trial period does not expire until August 28, 2016. [5 TTABVUE.] A motion to dismiss for alleged lack of prosecution is entirely inappropriate at this juncture and was filed in derogation of the plain language of the Trademark Rules of Practice. The Submission should be denied. *See*

Carl Karcher Enters. Inc. v. Carl's Bar & Delicatessen Inc., 98 USPQ2d 1370, 1373 (TTAB 2011) (denying request for involuntary dismissal for failure to present evidence where trial period had not yet expired).

C. The Board Should Deny Applicant's Submission as Improper.

In addition to being premature, the Submission fails to state a proper basis for the relief sought, misrepresents the status of this proceeding, mischaracterizes the tenor of settlement discussions between the parties, and violates procedural rules for filings before the Board. Therefore, to the extent the Board does not deny the Submission as premature, it should do so on grounds it is improper.

A motion submitted to the Board must “contain a full statement of the grounds [for the motion], and shall embody or be accompanied by a brief.” 37 CFR § 2.127(a). Applicant's Submission fails on both counts. Aside from the fact that the Submission does not offer legal argument or cite to any supporting law, it fails to articulate why Opposer has supposedly failed to meet its evidentiary burden. [9 TTAB.] It offers only generalized criticism of Opposer's position, which is plainly insufficient to obtain the relief Applicant is seeking. *See Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012) (explaining that relief under 37 CFR § 2.132 is not available unless the plaintiff has not introduced any evidence at all by the end of the trial period, and that disagreements over the impact of evidence do not support dismissal); *accord Coding Tech. GmbH v. Am. Audio Components Inc.*, 76 USPQ2d 1638, 1639 (TTAB 2005) (“Applicant, for its part, does not argue that opposer failed to take testimony or offer evidence during its assigned testimony period. Rather, applicant argues that opposer's proffered testimony and evidence are insufficient for a variety of reasons. However, a motion for

involuntary dismissal under Trademark Rule 2.132(a) is available only when a plaintiff fails to take testimony or introduce any evidence prior to the expiration of its testimony period.”).

Also troubling is the Applicant’s false assertion that the parties “were required to share documents with each other” by July 28, 2015, despite the fact that the Board’s Order of October 2, 2015—filed in response to Applicant’s own request to extend the timeline of this proceeding—provided for discovery through the end of May 2016. [5 TTAB.] Applicant did not request any documents from Opposer during the discovery period. [Ex. A at ¶ 7.]

Moreover, the Submission falsely states that Opposer “has not proffered a proposal” for settlement. [5 TTAB.] Contrary to Applicant’s assertion, Opposer broached settlement during both the pretrial conference and the parties’ March 3, 2016 settlement conference. [*Id.* at ¶¶ 2-3. Rather than cooperate with Opposer, Applicant filed the Submission and failed to notify Opposer it had done so. [*Id.* at ¶ 4.] Opposer never received a copy of the Submission, which does not include a certificate of service as is required under the Trademark Rules of Practice. 37 CFR § 2.119(a) (“Every paper filed in the United States Patent and Trademark Office in inter partes cases... must be served upon the other parties. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.”); *see also* TBMP §§ 113.01 - 113.03.

In sum, in addition to being untimely, Applicant’s Submission is baseless and contains misstatements regarding Opposer that appear to be designed to mislead the Board as to Opposer’s conduct during this proceeding. The contents of the Submission are clearly improper, and the relief sought therein should be denied. *See Suthern v. Fed. Ideas Inc.*, 44 USPQ2d 1703,

1703 (TTAB 1997) (denying motion to dismiss due to, *inter alia*, applicant's "obvious unfamiliarity with the proper procedures set forth in the rules" and its decision to file "procedurally unfounded motions" rather than attempting to cooperate with opposer in good faith).

CONCLUSION

For the aforementioned reasons, Opposer respectfully requests that the Board issue an order denying the relief sought in Applicant's "Notice to Dismiss."

SEYFARTH SHAW LLP

Date: June 3, 2016

By: /Lauren M. Gregory/

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Attorneys for Opposer
Urgent Care MSO, LLC

EXHIBIT A

DECLARATION OF LAUREN M. GREGORY

I, Lauren M. Gregory, hereby declare:

1. I am an attorney at Seyfarth Shaw, LLP, counsel of record for Opposer Urgent Care MSO, LLC (“Opposer”) in *Urgent Care MSO, LLC v. VideoKall, Inc.*, Opposition No. 91222999, United States Patent and Trademark Office Trademark Trial and Appeal Board (the “Opposition”). I make this declaration in support of Opposer’s Response in Opposition to Applicant’s “Notice to Dismiss.” This declaration is based on my own personal knowledge and, if called upon to testify thereto under oath, I could and would do so competently.

2. I, along with my co-counsel, Julia K. Sutherland, participated in a discovery conference via telephone with representatives of Applicant VideoKall, Inc. (“Applicant”) on January 11, 2016. During the discovery conference, the possibility of settlement was discussed, but no settlement was reached at that time.

3. On March 3, 2016, Ms. Sutherland and I participated in another teleconference with representatives of Applicant. During this call, settlement terms were again discussed. No settlement was reached, but we were under the impression that Applicant would continue to work cooperatively with us and that settlement talks would continue.

4. I recently visited the TTABVUE page for the Opposition in order to consult the discovery schedule provided by the Board. I discovered that Applicant had filed a document entitled “Notice to Dismiss by Applicant” on April 22, 2016. I was previously unaware of this filing, as neither myself nor Ms. Sutherland had been served with a copy of it.

5. I would never have known about the “Notice to Dismiss by Applicant,” and my client’s rights could have been severely prejudiced, if I had not happened upon the filing on TTABVUE.

6. Opposer served Applicant with its Initial Disclosures, First Requests for the Production of Documents, First Interrogatories, and First Requests for Admission during the discovery period prescribed by the Board.

7. We were not served with Applicant's Initial Disclosures or any requests for discovery by Applicant during the discovery period, which is now closed.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 3rd day of June, 2016, at Atlanta, Georgia.

/Lauren M. Gregory/

Lauren M. Gregory

CERTIFICATE OF SERVICE

I hereby certify that on June 3, 2016, I served the foregoing RESPONSE IN
OPPOSITION TO APPLICANT’S “NOTICE TO DISMISS” by depositing a true copy thereof
in a sealed envelope, postage prepaid, in First Class U.S. mail addressed as follows:

Videokall, Inc.
10631 Barn Wood Lane
Potomac, MD 20854-1325

/ Lauren M. Gregory /

Lauren M. Gregory